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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,048	07/28/2003	Stuart Brown	26859-002UTIL	7394
30623 7590 10/05/2007 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			EXAMINER APANIUS, MICHAEL	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 10/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/629,048

Applicant(s)

BROWN, STUART

Examiner

Michael Apanius

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-26 is/are pending in the application.
- 4a) Of the above claim(s) 11, 13-15, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 12, 16-23 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/17/2007 has been entered. The amendments to claims 1, 8 and 17 are acknowledged. It appears that claim 8 was incorrectly labeled as an original claim.

### ***Drawings***

2. The drawings are objected to because the lines are not of uniform thickness. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the

Art Unit: 3736

remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informality: at page 3, line 20, it appears that "abstracting" is a typographical error. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 8, 10, 12 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mosse et al. (WO 00/44285).
6. Mosse discloses a method of extracting multiple tissue samples from a subject, comprising: inserting into the subject an instrument (figure 1) comprising a plurality of controllable tissue sampling devices (15, 21), each of said devices being located in a different position in an array along a longitudinal axis of a housing (figures 2a-2b), each

Art Unit: 3736

of said sampling devices comprising an isolated chamber (15); contacting a sampling device with a deployment signal (page 6, lines 20-22), said signal being a hydraulic signal (page 8, lines 6-8), said signal causing an opening (page 7, lines 4-6) of said chamber; removing (page 6, line 24) a tissue sample from an anatomical location adjacent to said chamber; and sealing (page 7, line 1) said chamber. The housing comprises an interior lumen containing a deployment control element (32). The chambers do not communicate the tissue sample to the interior lumen. The housing is solid and the deployment control device is embedded in said housing. The tissue sampling devices are fixed in position along an outside diameter and are radially disposed about an outer diameter and longitudinally disposed along the length of the instrument. The chambers are vacuum sampling chambers (page 6, lines 15-17). The sampling device are deployed simultaneously in time.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mosse et al. (WO 00/44285). Mosse does not expressly disclose that the volume of the isolated chamber ranges from 0.001 to 1 cubic millimeter. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary

skill in the art to make the volume of the chambers between 0.001 and 1 cubic millimeter because Applicant has not disclosed that this range of volumes provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a different chamber volume because the instrument would still successfully obtain biopsy samples. Therefore, it would have been an obvious matter of design choice to modify Mosse to obtain the invention as specified in claim 16.

9. Claims 7, 20-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosse et al. (WO 00/44285) in view of Sorensen et al. (US 5,320,627).

10. In regards to claim 7, Mosse discloses a heat conductive cover element (13) but does not expressly disclose a heating element. In regards to claim 20, Mosse does not expressly disclose heating the plurality of sampling devices, wherein the heating causes actuation of a mechanical portion, such that the mechanical portion collects a sample and retains the sample. In regards to claim 21, Mosse does not expressly disclose passing an electrical current through a portion of the extracting device. In regards to claim 22, a differential pressure is applied to a local chamber to such in the sample. In regards to claim 23, the samples can be ejected by pressurizing the chamber (page 7, lines 13-14). In regards to claim 26, the method further includes imaging a location of the sample fiberoptically (page 6, line 12).

11. Sorensen teaches a heating element that uses electrical current for causing actuation of a shape memory alloy mechanical portion to collect and retain a biopsy sample (column 10, lines 31-53). Sorensen teaches these components as an alternative to mechanical actuation.

12. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a heating element for causing actuation of a mechanical portion to collect and retain a biopsy sample as taught by Sorensen in place of the mechanical actuation of Mosse in order to achieve the predictable result of actuating a biopsy mechanism to obtain biopsy sample.

### ***Response to Arguments***

13. Applicant's arguments with respect to the previous prior art rejections have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8am-4:30pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3736

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

  
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